

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD W. HOLT

Appeal No. 95-1859
Application 08/055,100¹

ON BRIEF

Before: HARKCOM, Vice-Chief Administrative Patent Judge,
and McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER, Administrative Patent Judge.

PER CURIAM.

Decision on appeal under 35 U.S.C. § 134

¹ Application for patent filed May 3, 1993. The real party in interest appears to be Lexmark International, Inc.

Appeal No. 95-1859
Application 08/055,100

The appeal is from a decision of the Primary Examiner rejecting claims 1-4 under 35 U.S.C. § 103 over the prior art. We reverse, make a new ground of rejection of claim 3 under 37 CFR § 1.196(b) and make a recommendation under 37 CFR § 1.196(c).

The subject matter on appeal relates to a process to achieve printing of a non-barrier-layer, peel-off, adhesive label with a liquid ink having a mineral oil vehicle. The method is said to result in a label that avoids the expense and added bulk of a barrier layer because the microporous print-receiving label is said to prevent the mineral oil vehicle from reaching the adhesive layer (specification, page 2, lines 7-9; page 3, lines 15-19).

A. Interpretation of the scope of the claims

Prior to evaluating the prior art applied by the examiner, as well as other art which we found on our own, we believe it is appropriate to determine the precise scope of the claims on appeal.

Interpretation of a claim is a question of law. Based on our evaluation of the claims, when considered in light of

applicant's specification, we reach the following conclusions of law with respect to what is required by independent claim 1.

1. Independent claim 1 reads as follows

[indentation, paragraph numbering and bold ours]:

The method of preparing labels

having an organic adhesive backing **degradable by mineral oil** for affixing said labels to surfaces comprising printing on a **print-receiving lamination** with imaging **ink or toner containing mineral oil** as a vehicle,

- (1) said print-receiving lamination being in contact with a **lamination of said adhesive**, and
- (2) said adhesive being contacted by a **supporting lamination**,
- (3) said print-receiving lamination being of a porous material which holds said mineral oil of said ink or toner in the pores of said porous material away from said adhesive.

2. The claim requires using an ink or toner which contains a vehicle which is mineral oil.

3. The claim also requires using a laminate comprising at least three layers, as follows:

a. The first (or top) layer is a "print-receiving" layer referred to in the claim as a "print-receiving lamination."

b. The second (or middle) layer is an adhesive layer referred to in the claim as a "lamination of said adhesive" or "adhesive backing." The adhesive must be an "organic adhesive" which is "degradable by mineral oil." The specification reveals the nature of what applicant means by "degradable." Basically, the adhesive is one which when contacted by the mineral oil is degraded to the point where it loses "its condition as an adhesive" (specification, page 1, lines 13-14).

c. The third (or bottom) layer is a "support layer" referred to in the claim as a "supporting lamination."

4. The "print-receiving" layer must be in contact with the "adhesive" layer. There can be no barrier layer between the "print-receiving" layer and the "adhesive" layer.

5. The "adhesive" layer must contact the "support layer."

6. The claim is directed to a method for making a printed label which comprises using the ink or toner described in Paragraph 2 on a three-layer laminated material described in Paragraphs 3 through 5. The step of the process is printing.

7. The ink or toner placed on the print-receiving layer must not come in contact with the adhesive.

B. Discussion

The examiner has rejected claims 1-4 as being unpatentable under 35 U.S.C. § 103 over a TESLIN® product brochure and Carley, U.S. Patent 3,790,703 (1974). "The prior art status of the product brochure is not questioned" (Appeal Brief, page 4). Carley is prior art under 35 U.S.C. § 102(b).

As noted above, the claims require printing on a three-layer laminate having specific layers arranged in a particular manner. We can agree with the examiner that the TESLIN® product brochure (1) describes the use of a film material which has the characteristics of applicant's print-receiving layer; (2) says that TESLIN® film "is great for *** Labels" (page 1); (3) says that TESLIN® film "allows inks to set almost instantly" (page 2); (4) says that inks "will penetrate

Appeal No. 95-1859
Application 08/055,100

the surface [of the TESLIN® film] to root into the structure" (page 3); (5) says that TESLIN® film can be used in laminates (page 10) and (6) says that TESLIN® film is sold inter alia in standard gauges of 8 mil (page 4) (note claim 4 requires a thickness on the order of magnitude of 0.008 of an inch thick). The brochure also states, however, that TESLIN® film "requires a special ink" (page 1), but no particular special ink is described in the brochure. The brochure does not describe the three-layer label configuration required to be used in the process defined by applicant's claim 1. Nor does the brochure describe the use of an ink or toner containing mineral oil as a vehicle, although ink containing mineral oil as a vehicle is old. See Carley, col. 5, lines 10-13 and Kirk-Othmer, Encyclopedia of Chemical Technology, Vol. 11, pages 611-620 (2d ed. 1966), particularly page 616 wherein it is said that letterpress inks contain mineral oil.

The problem with the examiner's rejection is that it is not supported by the evidence. The examiner has not established that the three-layer label laminate used in the process defined by claim 1 is old. Nor has the examiner established that it would have been obvious to use a mineral

Appeal No. 95-1859
Application 08/055,100

oil-containing ink to print on the three-layer label laminate called for by applicant's claim 1.

Independent of the examination conducted by the examiner, we have found that the film used to make applicant's print-receiving layer is old. See Young, U.S. Patent 4,861,644. Young tells us that letterpress printing may be used to accomplish printing on a print-receiving layer (col. 11, lines 33-39). Kirk-Othmer further tells us that letterpress newsprint inks are based mainly on mineral oil (page 616, fourth paragraph). But like the product brochure, Young does not describe the three-layer label called for by the process of claim 1. We have also found that three-layer labels are old. See Beck, U.S. Patent 3,660,203 (1972) (Fig. 2 and col. 1, lines 61-66). However, the print-receiving layer described by Beck is not a TESLIN® film layer. More important is the fact that the brochure, Young, Beck and Kirk-Othmer do not describe printing with a mineral oil such that the ink does not come into contact with the adhesive layer, as required by claim 1. On this record, we conclude that applicant has discovered a new characteristic for microporous plastics

Appeal No. 95-1859
Application 08/055,100

sheets and has claimed his discovery, as he must, in the form of a new and unobvious process.

For the reasons given, we reverse the prior art rejection made by the examiner.

C. New ground of rejection and recommendation

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention. Claim 3 contains the phrase "Teslin brand synthetic paper." TESLIN® is a registered trademark. Where a trademark is used in a claim as a limitation to identify a material, the claim does not comply with the requirements of 35 U.S.C. § 112, second paragraph. See the rationale set out in Ex parte Simpson, 218 USPQ 1020, 1021-22 (Bd. App. 1982).

In accordance with 37 CFR § 1.196(c), we recommend that the applicant amend claim 3 by replacing the phrase "Teslin brand synthetic paper" with the language "microporous plastic sheet" (specification, page 2, lines 15-16), and if such amendment is made our new ground of rejection under 37 CFR § 1.196(b) will have been overcome.

Appeal No. 95-1859
Application 08/055,100

D. Decision

The decision of the examiner rejecting claims 1-4 over the prior art is reversed.

E. Time for taking action

This opinion contains a new ground of rejection pursuant to Rule 196(b) (37 CFR § 1.196(b), amended effective Dec. 1, 1997). See Notice of Final Rule, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), reprinted in 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

Rule 196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

Rule 196(b) also provides that the applicant, **WITHIN TWO MONTHS FROM THE DATE OF ENTRY OF THIS DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected,

Appeal No. 95-1859
Application 08/055,100

or both, and have the matter reconsidered
by the examiner, in which event the
application will be remanded to the
examiner. . . .

(2) Request that the application be
reheard under § 1.197(b) by the Board of
Patent Appeals and Interferences upon the
same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED

(37 CFR § 1.196(b) and 37 CFR § 1.196(c))

GARY V. HARKCOM, Vice Chief)
Administrative Patent Judge)
)
)

)

Appeal No. 95-1859
Application 08/055,100

FRED E. McKELVEY, Senior)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
<hr/>)	
RICHARD E. SCHAFER)	
Administrative Patent Judge)	

Appeal No. 95-1859
Application 08/055,100

cc (via First Class mail):

John A. Brady, Esq.
LEXMARK INTERNATIONAL, INC.
Intellectual Property Law
740 New Circle Road, N.W.
Lexington, KY 40511-1876